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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/815,399	03/10/97	LYNCH J	85160.911CII

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EXAMINER	
MOHAMED, A	

ART UNIT	PAPER NUMBER
2763	6

DATE MAILED: 01/28/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/815,399	Applicant(s) Lynch et al.
	Examiner Ayni Mohamed	Group Art Unit 2763

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-4 and 16-29* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-4, 16-21, and 24* is/are rejected.

☒ Claim(s) *22, 23, and 25-29* is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Claims 1-4 and 16-29 are presented for examination.

2. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-4 and 16-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,515,524. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to a person of ordinary skill to practice the broadly claimed invention of claims 1-4 and 16-29 of the instant application without diverting from the scope of the claims 1-6, of patent number 5,515,524.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6, 16-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richek et al.

Richek et al. taught the invention substantially as claimed, including a data processing ("DP") system (as example in claim 6) comprised:

a method of generating a configuration configuring system in a computer (e.g., see the abstract);

providing structural model hierarchy having structural relationships (e.g., see col. 4, lines 27-63, col. 7, lines 29-64, col. 21, lines 28-50, col. 22, line 58- col. 25, line 34, claims 9-11);

providing a configuration instance (e.g., see col. 4, lines 27-46) and modifying the instance in response to a request by creating a model based on the request;

storing the modification as a list (e.g., see col. 47, lines 7-10);

examining said instance to determine if a constraint (conflict) exists (e.g., see col. 42, lines 42-44); and resolving/satisfying the conflict/constraint when exists (e.g., see col. 42, lines 45-50).

7. Richek et al did not specifically detail instance or constraint, exactly as claimed in the instant application. However, it would have been obvious to a person of ordinary skill in the art, at the time the claimed invention was made, Richek's configuration file statement including fields is the same as the claimed instance, and the claimed constraint is the same as Richek's conflicts.

8. As to claims 17 and 24 are the program code to practice the system of claims 1-4, claims 17 and 24 are rejected based on the rejections of claim 1.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references taught a system of configuration.

Benson et al (e.g., see the abstract).

Ciccarelli et al (e.g., see the abstract).

Waldron et al. (e.g., see the abstract).

Bennett et al (e.g., see the abstract).

10. Claims 22, 23 and 25-29 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning this communication should be directed to A. Mohamed at telephone number (703) 305-9694.

AM
A. Mohamed/kw

KEVIN J. TESKA
SUPERVISORY
PATENT EXAMINER